

REMARKS

Reconsideration and withdrawal of the rejections of the claimed invention is respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 16, 21, 23, 25, and 28-33 are pending in this application. No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112.

II. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME

Claims 16, 21, 23, 25, and 28-33 were rejected as allegedly being obvious by Pappas-Fader et al. (US 5,736,486 - “Pappas-Fader”) and Kazutomi et al. (JP 10-330202 - “Kazutomi”). The applicants maintain their position from their previous response and request reconsideration of this rejection for the following additional reasons.

No reason to combine patentably distinct elements of Pappas-Fader and Kazutomi to arrive at the applicants’ claimed liquid formulation

As noted in the Office Action, the elected invention is a combination of a) **sodium di-(2-ethylhexyl)sulfosuccinate** and b) **iodosulfuron**, i.e. this combination of a polycarboxylic acid and ALS inhibitor has been deemed to be patentably distinct from other combinations of polycarboxylic acid and ALS inhibitors.

When considering the Pappas-Fader reference as a whole, it is clear that the application is directed toward synergistic combinations of **anilofos** (see col. 1, Formula I) and an herbicide of Formula II (see col. 2, line 5 – col. 4, line 41). None of these herbicides represent iodosulfuron. In fact, Pappas-Fader despite reciting several different types of Formula II herbicides, appears to direct one of ordinary skill in the art solely to **propanil** (see Title of the Invention – “Herbicidal Mixture of Anilofos and Propanil”).

Pappas-Fader generally mentions surfactants such as dialkyl sulfosuccinates (see col. 11, lines 9-29). However, there is no direction for selecting this particular type of surfactant much less selecting this surfactant with iodosulfuron.

In addition, in Pappas-Fader's description about different types of formulations, the only formulation which even requires the presence of a surfactant is the water-dispersible and water-soluble granules, tablets and powders (see table in col. 10, lines 50-62) which is a liquid formulation as claimed by the applicants.

The applicants are aware of the teachings of Kazutomi as it is assigned to a subsidiary (Bayer Agrochem KK) of the same parent (Bayer CropScience) as the present application. Combining the teachings from Kazutomi with Pappas-Fader does not establish a *prima facie* holding of obviousness.

One of the elements of the claimed formulation is that the iodosulfuron is dissolved in the liquid formulation. In addition to not being specific for iodosulfuron, even if one of ordinary skill in the art were permitted to "pick and choose" from Kazutomi to the exclusion of other elements disclosed therein, Kazutomi only results in a *suspension*, i.e. the active herbicide is not dissolved.

In summary, the combination of Pappas-Fader and Kazutomi does not establish that the applicants claimed liquid formulation with sodium di-(2-ethylhexyl)sulfosuccinate and iodosulfuron is obvious because: (1) none of the references suggests this combination of compounds; (2) none of the references directs one of ordinary skill in the art to use sodium di-(2-ethylhexyl)sulfosuccinate; and (3) does not suggest that the use of sodium di-(2-ethylhexyl)sulfosuccinate would result in the dissolving of iodosulfuron.

Applicants have also shown evidence of unexpected results

Although not required because of the deficiencies of the combination of Pappas-Fader and Kazutomi, the applicants have provided further evidence of the non-obviousness of the claimed liquid formulation by way of the evidence of unexpected results shown in the specification and further described in the Declaration by Dr. Roland Deckwer (submitted herewith – "Deckwer declaration"), i.e. the production of a stable liquid formulation and/or resulting greatly reduced loss of the active ingredient (iodosulfuron).

The arguments in the Office Action appear to suggest that the evidence presented was not tested in the manner suggested by the Examiner. However, the suggested tests are not within the scope of the examples disclosed in either Pappas-Fader or Kazutomi. As the applicants are not required to test against their own invention, it is well known that the applicants are permitted to

test against an example which is closer to the applicants claimed invention than the invention taught or suggested by the prior art relied upon by the Examiner. *See In re Holladay*, 584 F.2d 384, 199 USPQ 516 (CCPA).

The table on page 2 of the Deckwer declaration includes data from Table 1 and Table 2 of the application (see pages 11 and 12 of the U.S. publication of the application) and compares the stability against supplemental formulation examples outside the scope of the applicants' claims.

As noted in the "Discussion of Results" in the Deckwer declaration, Example III includes sulfosuccinates and propylene carbonate as the solvent and can be compared against A Comp. III or B Comp. III. Not only is the liquid formulation of the invention stable as opposed to being unstable, the liquid formulation of the invention results much reduced loss of iodosulfuron (0.1% vs. 34.3/26.0%).

This effect is even greater when other herbicides are added in combination with iodosulfuron, i.e. when comparing Example VIII against C Comp. VIII & IX, D Comp. VIII & IX and 1 and 2 from Table 2, the liquid formulation of the invention stable as opposed to being unstable, the liquid formulation of the invention results much reduced loss of iodosulfuron (3.2% vs. 54.3%, 95.6%, 75.2% or >96.3%).

Nothing within the teachings of Pappas-Fader or Kazutomi alone or in combination suggests this level of stability or prevention of loss of active ingredient and provides a further indicia of non-obviousness.

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By: /Howard C. Lee/
Marilyn M. Brogan Howard C. Lee
Reg. No. 31,223 Reg. No. 48,104
Telephone: (212) 588-0800
Facsimile: (212) 588-0500